

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

REMARKS

Claims 1-4 and 6-12 are pending in the application. All claims have been rejected under various provisions of § 112. Each rejection is addressed in the order presented in the last action.

35 U.S.C. § 112,1st paragraph

a. Claim 1 has been amended by deleting the reference to sulphones. Accordingly, the rejection based on the alleged lack of enablement of sulphone group-containing side arms is mooted.

Withdrawal of the rejection is respectfully requested.

b. With respect to claim 2, Examiner's belief that the claim encompasses main chains having polyacrylic acid, etc, is not enabled is believed incorrect for the reasons set out below. Respectfully, it appears that Examiner may be confusing the reaction between dicarboxylic acids with the resultant structure of a polycarboxylic acid generated from acrylate.

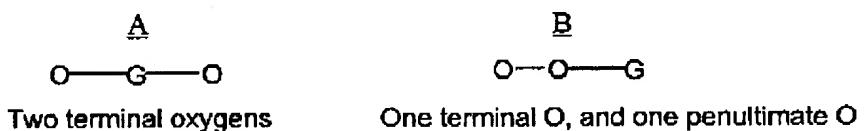
This rejection is predicated on Examiner's belief that polyacrylic acids, polymethacrylic acids, etc. are polyanhydrides. The attached pages from the Concise Encyclopedia of Polymer Science and Engineering definitively show that this conclusion is incorrect. Comparing the structures of a polyanhydride and a polyacrylate demonstrates that they are neither identical nor equivalent insofar as polyacrylates provide for a free carboxyl side group for side-arm attachment.

The reason for this apparently lies in the greater reactivity of addition at acrylic acid's double bond as compared to a dicarboxylate's polycondensation reaction.

Withdrawal of the rejection is respectfully requested.

c. Examiner maintains that claim 3 is not enabled because the structural formulae in claim 3 indicate attachment via a peroxide linkage. Applicants respectfully disagree.

By requiring G to have at least two terminal oxygens we obtain structure A below. Examiner's assertion that two terminal oxygens provide structure B is incorrect, as there is only one terminal oxygen. Only structure A complies with the plain meaning of the phrase *two terminal oxygens*.



In addition, structure A would clearly form an acyl linkage with the free carboxyl ate side group in the polyester backbone, not a peroxide linkage. See e.g., the attached structure for polyacrylate. It is noted that with respect to group T's two terminal acyl groups, Examiner has correctly interpreted this limitation. Page 3, paragraph 10, of the final action. Therefore, it is unclear why he believes that two terminal oxygens in claim 3 provides a G having structure B.

Further support for this interpretation is that D has two terminal acyl groups allowing condensation reactions on each side, to form an acyl link between G and D. Neither the linkage of G to the backbone, nor to D could take place if Examiner's peroxide scenario were accurate.

It is longstanding practice that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. MPEP § 2111.01, citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Thus, G having two terminal oxygens is not encompassed by a peroxide structure.

In addition, by interpreting the claim as requiring aperoxide, Examiner is improperly ignoring the specification's teachings. See also *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) ("Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'." 710 F.2d at 802, 218 USPQ at 292. (Emphasis in original)).

Withdrawal of this rejection is respectfully requested.

d. With respect to claims 3, and 7-9, it is not clear what the basis of the nonenablement rejection is, other than Examiner states that -COOR⁶ groups would result in an α -ketoacid. Respectfully, this conclusion by itself is insufficient to maintain a lack of enablement rejection.

A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. MPEP § 2164.01. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971).

Examiner has not explained why preparing side arms with a terminal α -ketoacid would not be within the grasp of the ordinary skilled artisan. Respectfully,

Examiner has not indicated how the disclosed manner of making the claimed comb polymers would fail to yield species having side arms with terminal α -ketoacid groups.

Accordingly, in the absence of sound technical reasoning explaining the specification's shortcomings, it is respectfully suggested that the rejection be withdrawn.

35 U.S.C. § 112, 2nd paragraph

a. Examiner believes that the reference to average molecular weight in claim 3 is indefinite because it does not specify the type of average molecular weight.

Applicants have amended the claim to require that the sum of $\alpha + p$ must be between 2 and 1000. In the final action, examiner states that α and p would not be expected to have an effect on the molecular weight of the main chain. However, this is not what the claim limitation in claim 3 is directed to. The limitation in claim 3 is directed to the molecular weight of the main chain's repetitive unit. In other words, e.g., an acrylate monomer plus its side arm.

Using the specification, the minimal formula weight (not molecular weight) for the repetitive unit of an acrylate and the smallest side arm unit, is approximately 802 daltons. Using the same approach, the maximum formula weight of a side arm is approximately 2700 daltons.

The sum of $p + \alpha$ being between 2 and 1000 would provide a repetitive unit of formula weight between 1600 and 2×10^6 daltons. Although the formula weight is not the exact value of the average molecular weight, it is not vague or indefinite in that it provides a clearly defined range of " $p + \alpha$."

Even if different means of determining average molecular weights vary, persons of skill in the art would extract from the claim a clearly defined range of values for the sum of p and α . Further, this range of $\alpha + p$ provides for the described species of repeating units to

fall within the teachings of specification, even if a given method of average molecular weight determination may vary somewhat; i.e., even considering that one method may be off somewhat. Thus, this claim limitation is enabled and adequately described by the specification.

Withdrawal of this rejection is respectfully solicited.

b. The claims have been amended to remove vague and unnecessary uses of "can" and "may not." In some cases, the term may is believed acceptable as a means of claiming in the alternative.

c. With respect to the definition of R¹, it is believed that this rejection is addressed by amendment.

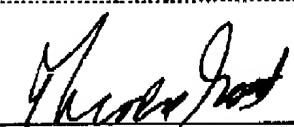
d. R² is claimed in one embodiment as a polyethoxylated radical that is capable of binding to T via an ether function. Respectfully, it is not clear where the indefiniteness lies as polyethoxylated radicals are well known in the art.

e. Claim 6 was amended according to Examiner's suggestion.

f. Claim 8 was amended according to Examiner's suggestion.

Respectfully Submitted,

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